

REMARKS

In the Office Action mailed October 18, 2004, the Examiner objected to claims 37 and 70 due to various informalities. The Examiner also rejected claims 37-70 under 35 U.S.C. § 102(e) as being anticipated by WO 98/17405 wherein the Examiner used U.S. Patent 6,292,709 to *Uhl et al.* ("*Uhl*") as an English equivalent and for citations.¹

By this amendment, Applicant has amended claims 37 and 70 without prejudice or disclaimer to cure the informalities noted in Examiner's objections. Moreover, Applicant has amended claims 37, 47, 58, 69, and 70 to further define and clarify the invention. Claims 1-36 and 71-140 have been withdrawn. Accordingly, claims 37-70 remain pending.

¹ Applicant notes that the Examiner's rejection is based on 35 U.S.C. § 102(e) and cites WO 98/17405, an international application. For an international application to qualify as prior art under § 102(e), it must (1) have an international filing date on or after November 29, 2000, (2) designate the United States, and (3) be published under PCT Article 21(2) in English. 35 U.S.C. § 102(e).

Because the WO 98/17405 reference does not meet the criteria above, it does not qualify as prior art under § 102(e). Consequently, Applicant does not understand why that reference was cited. Nevertheless, for purposes of responding to the rejection, Applicant presumes that the Examiner intended to base the rejection solely on the U.S. patent.

Claim Objections

The Examiner objected to claims 37 and 70 for various informalities. By this amendment, Applicant has corrected the informalities noted in Examiner's objections. Applicant respectfully submits that this amendment correcting the informalities does not narrow the scope of the claims and is not for reasons related to patentability. Accordingly, Applicant respectfully requests that the Examiner withdraw the objections.

Claim Rejections Under 35 U.S.C. § 102

The Rejection of Claims 37-70 Under 35 U.S.C. § 102(e) As Being Anticipated by *Uhl*.

In the Office Action, the Examiner rejected claims 37-70 under 35 U.S.C. § 102(e) as being anticipated by *Uhl*. For the reasons set forth below, however, Applicants respectfully request that the rejection is improper and that Examiner withdraw the rejection.

In order to properly establish that a prior art reference anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The cited reference, *Uhl*, however, does not disclose each and every element of the claims as required by § 102.

Amended claim 47 is patentably distinguishable over *Uhl* at least because *Uhl* does not disclose "reconstructing the illegible first code using the received data without

manual intervention" in conjunction with the other recited limitations as claimed.

Support for this amendment is found in the specification, at least on Page 22, lines 15-18 and Page 23, lines 15-17.

Uhl discloses, among other things, a method and device for online processing of mail items to be forwarded. See *Uhl*, Abstract, lines 1-2. In *Uhl*, if the address block is illegible following OCR, it is forwarded to a video coding system where a video coding operator inputs the address information or makes selections from lists of alternatives for the address information. See col. 9, lines 34-52. For mail items that cannot be evaluated by the operator of the video coding system, the mail item is imprinted with an ID-tag that is stored in the ID-tag server, together with the sorting code information, the complete address block information, and the information on possibly existing delivery notations or advance instructions. See col. 9, lines 53-58.

The Examiner asserts that retrieval of the address block information from the ID-tag server via the ID-tag constitutes reconstructing the first code as claimed. Office Action, Page 3. Applicant, however, respectfully submits that such a retrieval step in *Uhl* occurs after the video coding process that involves manual intervention by an operator as noted above. Therefore, because reconstructing the illegible address block in *Uhl* involves manual intervention by an operator, *Uhl* does not disclose "reconstructing the illegible first code using the received data without manual intervention" as claimed in the amended claims.

Although *Uhl* in col. 9, lines 34-36 and lines 62-63 characterizes the online system in Fig. 13 to be for "automatic processing of items to be forwarded or returned," the online system nevertheless includes a video coding process that involves manual

intervention by an operator as noted above. Moreover, in *Uhl*, the small number of items that are moved to the special rough sorting compartment that could not be identified online are also subjected to the same video coding process. See col. 10, lines 13-18. Therefore, manual intervention is required for those items as well.

Accordingly, the Examiner's rejection of independent claim 47 under 35 U.S.C. § 102(e) is no longer applicable and must be withdrawn. Amended independent claims 37, 58, 69, and 70 contain commensurate limitations and are allowable at least for the same reasons.

Moreover, dependent claims 38-46, 48-57, and 59-68 are also allowable for at least the reasons above regarding independent claims 37, 47, and 58, and because they depend upon independent claims 37, 47, and 58. Accordingly, Applicant respectfully requests withdrawal of the rejection of the dependent claims.


In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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